

## REMARKS

Reconsideration of the present application is respectfully requested. Claims 1, 42 and 57 have been amended. Claims 5, 46 and 61 have been canceled in this response (claims 16-41 were previously canceled). Claims 72-74 have been newly added. No new matter has been added.

### Claim Rejections

Independent claim 1 stands rejected under 35 U.S.C. § 102(e) based on Tso (U.S. Patent no. 6,088,803). Dependent claim 5, which depends on independent claim 1, stands rejected under 35 U.S.C. § 103(a) based on Tso in view of Midgely et al. (U.S. Patent no. 5,604,862). Applicant respectfully traverses the rejections.

Claim 1, as currently amended, essentially includes the limitations of claims 1 and 5 as previously presented. Claim 1 recites:

1. (Previously presented) A method including
    - receiving a user request for an object maintained at a server;
    - selecting a cluster device from a plurality of cluster devices to perform an operation on the object according to a classification of the plurality of cluster devices based on a performance criterion, wherein each of the plurality of cluster devices is a separate device from the server;**
    - upon a request from the server, performing the operation at the cluster device, said operation including accessing said object at said server and determining a result of processing said object at said cluster device; and
    - conditionally allowing access to said object in response to said user request based on said result.
- (Emphasis added)

Applicant appreciates the Examiner's acknowledgement that Tso does not teach or suggest selecting a cluster device to perform the operation in response to a priority class associated with the cluster device (*see* Office Action mailed on 7/24/2006, page 7). The Examiner, however, contends that Midgely teaches that each cluster device maintains a hierarchical storage system

and that it would be obvious to a person in the art at the time the invention was made to modify the method in Tso for the cluster device to perform the operation in response to a query for a more frequently used item that the cluster has stored in the faster, yet more expensive memory. The Examiner further alleges that the modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Midgely suggests that using a hierarchical storage system has the advantage of allowing access to frequently used items more quickly.

One of the basic requirements of a *prima facie* case of obviousness is that the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP §2143.

Tso does not teach or suggest the above emphasized limitation in claim 1 (as admitted by the Examiner). Neither does Midgely teach or suggest the emphasized limitation. Midgely discloses a hierarchical storage system, not a plurality of cluster devices. A storage system is different from a cluster device as a storage system is used for storing information, whereas a cluster device, as recited in claim 1, handles an operation of accessing an object and determining a result of processing the object. Thus, Midgely does not teach or suggest selecting a cluster device from a plurality of cluster devices to perform an operation on the object according to a classification of the plurality of cluster devices based on a performance criterion, wherein each of the plurality of cluster devices is a separate device from the server, recited in claim 1.

In addition, there is no motivation to combine the teachings of Tso and Midgely. The Examiner alleges that a person having ordinary skill in the art, at the time the invention was made, would have been motivated to combine the teachings of Tso and Midgely since Midgely suggests that using a hierarchical storage system has the advantage of allowing access to

frequently used items more quickly. However, allowing access to frequently used items more quickly is different from scanning a file more quickly. Thus, there is no motivation or suggestion to combine the teachings of Tso and Midgely.

In addition, Tso and Midgely are trying to solve different problems. Tso is to solve the problem of preventing virus spreading in the context of client downloading a file from a server. However, Midgely is to solve the problem of providing data protection against failures of storage devices by using different levels of storage devices.

Thus, at least for the above reasons, claim 1 is not obvious in view of the cited prior arts (Tso and Midgely). Therefore, claim 1 and all claims which depend on it are patentable over Tso and Midgely.

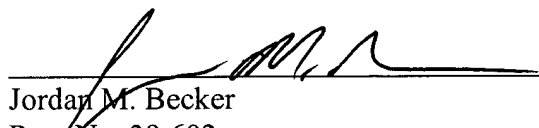
Independent claims 42 and 57 each recites limitation similar to that discussed above for claim 1. For similar reasons, claims 42, 57 and all claims which depend on them are also patentable over Tso and Midgely.

For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: October 23, 2006

  
\_\_\_\_\_  
Jordan M. Becker  
Reg. No. 39,602

Customer No. 48102  
12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1030  
(408) 720-8300